

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Applicant(s): R.A. Budd et al.
Docket No.: YOR920030088US1
Serial No.: 10/764,638
Filing Date: January 26, 2004
Group: 2629
Examiner: Alexander S. Beck

Title: Compact Optical System and Packaging for Head Mounted Display

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants respectfully provide the following comments for consideration by the Board of Patent Appeals and Interferences in response to the Examiner's Answer dated July 30, 2009. Appellants thank Examiner Beck for elaborating on the rationale for his rejections of claim 1.

ARGUMENT

Claim 1 (Pages 3-8 of the Answer)

With regard to the §103 rejection, Appellants initially note that the Examiner may not rely on impermissible hindsight when reaching a determination of obviousness under 35 U.S.C. §103(a). The MPEP categorically states that “[k]nowledge of applicant’s disclosure must be put aside in reaching this determination . . . [t]he tendency to resort to “hindsight” based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However,

impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” MPEP 2142.

In the Examiner’s Response to Argument at page 6 of the Examiner’s Answer, the Examiner contends that it would be obvious to one of ordinary skill in the art to reposition the protective shade of Fan onto the backside of the interface pod of Robertson, such that, instead of being positioned at the front-end (i.e. between the user’s eye and the display, as disclosed in Fan), the shade would be positioned on the back-end of the optical system (i.e. behind the optical system). Appellants respectfully assert that a person having ordinary skill in the art would not be motivated to position an opaque shade behind the optical system.

Appellants’ limitation recites that when the opaque light shield is in the closed position, the image signal is still viewable by the user, only then with background light blocked from entering the optical system and thereby eliminated. Since Fan seeks to have all access to the display and lens covered by its protective shield, necessarily blocking the view of the display in order to prevent damage, a person having ordinary skill in the art at the time of Appellants’ invention would have been counseled away from using an opaque light shield to block light on only the “back” side of the display while still allowing visual access to the optical display screen. Appellants respectfully submit that the true motivation for using a light shield on the “back” side of the display while leaving the “front” optical system exposed to view stems from Appellants’ own disclosure. In accordance with the authority cited above, such a use constitutes impermissible hindsight when formulating an obviousness rejection.

In view of the above, Appellants respectfully maintain that claim 1 is in condition for allowance, and again request reversal of the §103 rejection.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William E. Lewis". The signature is fluid and cursive, with the first name "William" being the most prominent part.

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